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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD G. HYATT, JR.

Appeal 2011-006302
Application 08/720,070
Technology Center 3600

Before JOHN C. KERINS, MICHAEL W. O'NEILL, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

SILVERBERG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Richard G. Hyatt, Jr. (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 25, 26, 28, 30-33, 39-42, 46-52, 54-56, 64, 70, 76, 77, 82-84, 90, 91, 105, 107, 108, 109, 111, 113-116 and 119-121. We have jurisdiction under 35 U.S.C. § 6(b). Appellant's counsel presented oral argument on June 14, 2011.

We REVERSE.

THE INVENTION

Appellant's claimed invention is directed to plugs and cylinders for electromechanical locks (Spec. 1:10-11).

Claim 25, reproduced below, is representative of the subject matter on appeal.

25. A lock, comprising:
a shell containing a hollow recess defining a longitudinal axis and an interior cylindrical surface;
a cylinder plug rotatable around said longitudinal axis while resident within said hollow recess;
a stationary bar borne by said shell and interposed between said shell and said cylinder plug to create an obstruction to rotation of said cylinder plug within said recess;
said cylinder plug comprising:
a first base and a second base separated by an axial length of said cylinder plug from said first base, said second base configured to support a cam; and
an electrical operator borne by said cylinder plug and rotatable with said cylinder plug, said electrical operator being electrically operable to respond to a control signal by moving independently of said bar between one of a first orientation accommodating relative movement between said shell and said cylinder plug and

a second and different orientation maintaining obstruction of said relative movement by engaging said bar, and another of said first orientation and said second orientation.

THE REJECTIONS

The following rejections¹ by the Examiner are before us for review:

1. Claims 90 and 120 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
2. Claims 25, 26, 28, 30-33, 39-42, 46-52, 54-56, 64, 70, 76, 77, 82-84, 90, 91, 105, 107, 108, 109, 111, 113-116 and 119-121^{2, 3}, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gokcebay (US 5,552,777, issued Sep. 3, 1996) in view of Thordmark (US 5,542,274, issued Aug. 6, 1996) and Gomez-Olea Naveda (US 4,416,127, issued Nov. 22, 1983) (hereafter “Naveda”).

ISSUES

The issues before us are: (1) whether the Examiner erred in finding that the invention called for in independent claims 90 and 120 does not comply with the enablement requirement of 35 U.S.C. § 112, first paragraph (App. Br. 74); and (2) whether the Examiner erred in concluding that the combined teachings of Gokcebay, Thordmark and Naveda would have

¹ The Examiner has withdrawn the provisional double patenting rejection of claims 1-5, 11-13, 34, 65-69, 75, 92-100, 112 and 121 over Hyatt (Ans. 3).

² All references to the Appeal Brief (App. Br.) in this Decision are to the Appeal Brief filed May 3, 2010.

³ In any further prosecution on the application, the dependency of claims 115 and 119, which depend from cancelled claim 85 (*see* App. Br. 5), should be corrected.

rendered obvious a plug and a cylinder for an electromechanical lock, as called for in the claimed invention (App. Br. 104).

ANALYSIS

Rejection of claims 90 and 120 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement

Appellant contends that claims 90 and 120 comply with the enablement requirement of 35 U.S.C. § 112, first paragraph, (App. Br. 74).

The Examiner found that “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention” (Ans. 4).

It is well recognized that 35 U.S.C. § 112, first paragraph, includes an enablement requirement that is separate from a written description requirement. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1345 (Fed. Cir. 2010).

The United States Patent and Trademark Office (USPTO) bears the initial burden when rejecting claims for lack of enablement. *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993).

It is well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 736-7 (Fed. Cir. 1988).

The Federal Circuit has identified the following factors to be considered in determining whether a disclosure would require undue

experimentation. They include:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Id. at 737.

We find that the Examiner's analysis does not evaluate the evidence as it relates to any of the factors noted *supra* in *In re Wands* to determine whether a disclosure would require undue experimentation.⁴

Thus, we are constrained to reverse the rejection of claims 90 and 120 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Rejection of claims 25, 26, 28, 30-33, 39-42, 46-52, 54-56, 64, 70, 76, 77, 82-84, 90, 91, 105, 107, 108, 109, 111, 113-116 and 119-121 over Gokcebay, Thordmark and Naveda

Appellant contends that (1) the Examiner's conclusion of obviousness includes a piecemeal consideration of each of the three references, but fails to consider the proposed combination as a whole (App. Br. 103); and (2) there is no evidence of record for modifying the primary reference in the manner asserted by the Examiner, except through a hindsight reconstruction of the art in the light provided by Appellant alone (App. Br. 115-116).

The Examiner found that (1) Gokcebay describes a solenoid/electrical operator 36 and a bar/detent/blocking pin 38 (Ans. 10), (2) "Gokcebay fails to teach a bar/detent/blocking pin being engaged by a locking member which

⁴ See also MPEP §§ 2164.01, 2164.01(a) (8th ed., Rev. 8, Jul. 2010)

moves independently of the movement of the bar/detent which is reciprocated between a blocking and releasing position as a result of independent movement of the locking member via the electrical operator” (Ans. 10), (3) “Thordmark [describes] a cylinder having an electronic operator 12, a laterally movable electronic locking member 11 which alternately allows and blocks reciprocation of a radially spring biased sidebar/detent 10” (*id.*) (Bold added), and (4) “Naveda further teaches the miniaturization of lock elements” (Ans. 13, *see also* Ans. 29-30).

The Examiner concluded that:

[i]t would have been obvious to one of ordinary skill in the art to replace the simple blocking element [38] of Gokcebay with the multi-part electrically actuated blocking element of Thordmark . . . [and i]t would have further been an obvious reversal of parts and change of size to select miniature logic circuitry and a miniature solenoid and *locking member 11* such that the blocking mechanism fits within a conventional sized lock plug as taught by Gokcebay and Naveda.

(Ans. 6-7, *see also* Ans. 11-12) (Italics and bold added).

As set forth *supra*, the Examiner’s conclusion of obviousness is based on the substitution of one blocking mechanism for another blocking mechanism, the miniaturization of the substituted blocking mechanism components, and a purported mere reversal of parts.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

In re Keller, 642 F.2d 413, 425 (CCPA 1981)

Thordmark describes a lock cylinder 2 accommodating a plug 3 (col. 4, ll. 57-61), a latching element 10, springs 15 acting against the end parts of the latching element 10 to urge the latching element towards the plug 3, an axially movable blocking element 11 for blocking and unblocking the latching element 10, and a motor 12 or a coil 17 for axially moving blocking element 11 to block or unblock the latching element 10 (col. 5, ll. 1-47).

Naveda describes:

Known elements usable in this invention [magneto-electronic lock] are, among other, micro-contacts, high-vacuum reading relays having one or more contacts, mercury micro-relays, *conventional miniature relays, miniature coils, miniature electromagnets*, semiconductors, Hall effect devices, electronic memories which can be positioned by a magnetic field, whether of ferrite, magnetic bubbles or bioelectric circuits, resistance plates which are variable by means of the interaction of a magnetic field on said plate, and crystalline structures in which the erratic or non-erratic movements of the free or freeable electrons are varied due to the magnetic field.

(Col. 3, ll. 1-13) (Italics added).

As set forth *supra*, the Examiner concluded that Naveda teaches miniaturizing Thordmark's locking member (blocking element) 11. We find that Naveda describes that it is old and well known in the magneto-electronic lock art to use miniature relays, miniature coils and miniature electromagnets. We find that Thordmark's locking member (blocking element) 11 is not a relay, coil or electromagnet. Thus, we conclude that Naveda does not teach miniaturizing Thordmark's locking member (blocking element) 11.

Further, the Examiner's findings and conclusion of obviousness do not articulate a reasonable basis with rational underpinnings as to how, and we do not see how, Thordmark's detent (latching element) 10 and locking

member (blocking element) 11, when substituted for Gokcebay's blocking pin 38, can be miniaturized and maintain sufficient strength to operate in their intended manner.

Thus, we are constrained to reverse the rejection of claims 25, 26, 28, 30-33, 39-42, 46-52, 54-56, 64, 70, 76, 77, 82-84, 90, 91, 105, 107, 108, 109, 111, 113-116 and 119-121 over Gokcebay, Thordmark and Naveda. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (“The legal conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.”)

CONCLUSIONS

The Examiner has erred in finding that the invention called for in independent claims 90 and 120 does not comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

The Examiner has erred in concluding that the combined teachings of Gokcebay, Thordmark and Naveda would have rendered obvious a plug and a cylinder for an electromechanical lock, as called for in the claimed invention.

DECISION

The decision of the Examiner to reject claims 25, 26, 28, 30-33, 39-42, 46-52, 54-56, 64, 70, 76, 77, 82-84, 90, 91, 105, 107, 108, 109, 111, 113-116 and 119-121 is reversed.

REVERSED

mls